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EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,053

Applicant(s)

ALLEN ET AL.

Examiner

Jason P. Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

By

DETAILED ACTION

Claim Objections

1. Claim 15 and all corresponding claims are objected to because of the following informalities: The claim should read, "new contact from a list stored". Appropriate correction is required.
2. Claim 41 on page 53 of the claims should be numbered "59".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 25, the preamble of the claim states, "wherein the set top box", but then the body of the claim recites, "for transmission to the set top box". This is indefinite because the set top box cannot transmit audio signals to itself. For the remainder of the Office Action, the examiner will equate the claim 21, which appears to be the claim the Applicant is attempting to mirror.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 10-12, 16-17, 19-35, 38-44, 47-49, 53-54 and 56-60 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by August et al. (U.S. Patent No. 5,671,267).

Referring to claim 1, August discloses a remote control for an interactive television system (see remote control 10 in Figure 1).

August also discloses that the remote control comprises a memory configured to store a list of contacts (see memory 136 in Figure 2 and Column 5, Lines 43-45 and Column 7, Lines 60-63), each contact having an associated address (see Figure 5 for the contact "Mom" having the telephone number (address) "908-555-1234") for establishing communication with the contact via the interactive television system (again note Figures 2 and 5 for communicating with set-top box 32, which establishes communication with the contact ("Mom") via the interactive television system (see Column 9, Lines 48-52)).

August also discloses that the remote control comprises a display device configured to display at least a portion of the list of contacts (see display 325 in Figure 3 and Column 7, Lines 60-63).

August also discloses that the remote control comprises a plurality of user controls configured to receive a user selection of a contact from the list (see Column 7, Lines 54-65), the user controls further being configured to remotely operate the interactive television system (see Column 8, Lines 3-17).

August also discloses that the remote control comprises a wireless transmitter (see duplexer 119 in Figure 2) configured to transmit the address corresponding to the selected contact to the interactive television system (see Column 4, Line 66 through Column 5, Line 20 and Figures 2 and 5) to initiate communication between a user and the selected contact (see Column 9, Lines 27-35 and Figure 5).

Referring to claim 2, August discloses that the display device comprises an LCD (see Column 5, Lines 40-43).

Referring to claim 3, August discloses a microphone configured to capture a first audio signal for transmission to the interactive television system via the wireless transmitter (see Column 5, Lines 17-20).

Referring to claim 4, August discloses a wireless receiver configured to receive a second audio signal and a speaker configured to generate audible output from the second audio signal (see Column 5, Lines 10-17).

Referring to claim 5, August discloses that the speaker and the microphone are further configured to operate simultaneously to provide two-way audio communication with the contact via the interactive television system (see Column 5, Lines 10-17 and Figure 5 and Column 9, Lines 27-56).

Referring to claim 6, August discloses that one address comprises a network address (see the telephone number for "Mom" in Figure 5 and note that a telephone number is a network address).

Referring to claim 7, see the rejection of claim 6 where August teaches a telephone address.

Referring to claim 10, August discloses a contact entry component configured to receive a user selection of a new contact to be entered into the list of contacts (see Column 7, Lines 63-65).

Referring to claim 11, August discloses that the user controls are further configured to enter a new contact into the list of contact stored in the memory (see the rejection of claim 10).

Referring to claim 12, see the rejection of claim 10.

Referring to claim 16, August discloses storing a visual identifier associated with each contact (see Column 7, Lines 60-63), the visual identifier being viewable by a user to identify an associated contact, wherein the display device is further configured to display the visual identifier (see Figure 5 for displaying a name and phone number on the remote control).

Referring to claim 17, August discloses that the identifiers comprise a plurality of characters forming a name of the contact (see Figure 5 for displaying the characters "Mom").

Referring to claim 19, August discloses that the visual identifiers comprise an iconic symbol (see Column 5, Lines 35-39).

Referring to claim 20, see the rejection of claim 1, and note that August further discloses a set-top box 32 in Figure 5 having a wireless receiver (antenna 214 and duplexer 215 in Figure 2) for receiving the address corresponding to the selected contact from the remote control (see Column 4, Line 66 through Column 5, Lines 1-11 and Column 6, Lines 35-57), the set top box 32 being further configured to establish

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two-way communication with the selected contact via the interactive television system (see Column 9, Line 48 through Column 10, Line 44).

Referring to claim 21, see the rejection of claims 3-4.

Referring to claim 22, see the rejection of claim 5.

Referring to claims 23-24, see the rejection of claim 1.

Referring to claim 25, see the rejection of claim 21.

Referring to claim 26, see the rejection of claim 22.

Referring to claim 27, August discloses that the set top box comprises a memory configured to store the list of contacts (see Column 10, Lines 33-34).

Referring to claim 28, August discloses that the contacts are displayed on a television of the interactive television system (see Figures 2 and 5).

Referring to claims 29-35, see the rejection of claims 1, 10, 12-15 and 20, respectively.

Referring to claim 38, August discloses that the set top box comprises a telephone network component configured to initiate communication with the selected contact via a telephone network (see telephone circuit 211 in Figure 2).

Referring to claim 39, August discloses that the interactive television system comprises an output device for generating audible output (see television 60 in Figure 5 that output audio of the television program the viewer is currently watching), wherein the remote control comprises an input device for capturing an audio signal including the audible output (see microphone 122 at Column 5, Lines 17-20), wherein the set top box comprises a noise cancellation component configured to cancel the audible output from

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the captured audio signal (see Column 9, Lines 7-22 for muting the television signal when the telephone microphone is being used).

Referring to claim 40, see the rejection of claim 39.

Referring to claims 41-44, see the rejection of claims 1, 3 and 6-7, respectively.

Referring to claims 47-49, see the rejection of claims 10-12, respectively.

Referring to claims 53-54, see the rejection of claims 16-17, respectively.

Referring to claim 56, see the rejection of claim 19.

Referring to claims 57-58, see the rejection of claim 39.

Referring to claim 59, see the rejection of claim 1, 3-4 and elements 114 and 134 for receiving and outputting audio output from the interactive television system through duplexer 119 in Figure 2.

Referring to claim 60, see the rejection of claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 13-15, 45 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. (U.S. Patent No. 5,671,267).

Referring to claim 8, August discloses an interactive television system comprising the remote control disclosed in the rejection of claim 1. August also discloses using a

network address in the form of a telephone number used to call another person (see the rejection of claims 1-7). However, August is silent about the system of Figure 2 contacting a subscriber that contains the same system.

The examiner notes that it would have been obvious for a second subscriber to contain the interactive television system of Figure 2, as taught by August.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to have a second subscriber containing a second interactive television system, for the purpose of advantageously controlling the information provided by a remotely operated device in response to voice and data communications occurring over the telephone network (see Column 1, Lines 41-44 of August) in a single device.

Referring to claim 13, August discloses that the user controls are further configured to select a contact from the list (see Column 7, Lines 60-63) being displayed by the interactive television system (see Figure 5 for the television displaying the "Mom" contact) as the new contact (the examiner notes that at Column 7, Lines 63-65 a new contact can be entered and a contact can also be displayed on the TV in Figure 5, therefore, a new contact can be displayed after he/she has entered the new contact).

At the time the invention was made, it would have been obvious for a person of ordinary skill in the art, to select a new contact the first time after the user has entered the new contact into the contact list, for the purpose of facilitating ease of use for the user (see Column 4, Lines 9-12 of August).

Referring to claim 14, August discloses that the user controls are further configured to select a contact from the list (see Column 7, Lines 60-63) being displayed by the interactive television system (see Figure 5 for the television displaying the "Mom" contact) as the new contact (the examiner notes that at Column 7, Lines 63-65 a new contact can be entered and a contact can also be displayed on the TV in Figure 5, therefore, a user may contact a person in the contact list more than once, causing the user to contact another subscriber that the user has previously communicated with.

At the time the invention was made, it would have been obvious for a person of ordinary skill in the art, to select a contact the user has previously communicated with, for the purpose of facilitating ease of use for the user (see Column 4, Lines 9-12 of August).

Referring to claim 15, August discloses receiving a new contact from an external electronic device (see Column 11, Lines 48-55 for the set-top box determining the calling parties identification information and sending the identification information to the remote control for display). August fails to disclose that the new contact information is sent from a list stored on the external electronic device.

The examiner notes that it would have been obvious for a second subscriber to contain the interactive television system of Figure 2, as taught by August, thereby containing a list of contacts that can be communicated back to the first subscriber at the first interactive television system.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to have a second subscriber containing a second interactive

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television system, for the purpose of advantageously controlling the information provided by a remotely operated device in response to voice and data communications occurring over the telephone network (see Column 1, Lines 41-44 of August) in a single device.

Referring to claim 45, see the rejection of claim 8.

Referring to claims 50-52, see the rejection of claims 13-15, respectively.

6. Claims 9 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. (U.S. Patent No. 5,671,267) in view of in view of Katzur (U.S. Patent No. 6,240,303).

Referring to claim 9, August discloses all of the limitations in claim 3, but fails to disclose a voice recognition system.

Katzur discloses a voice recognition system (see Column 3, Lines 58-65) comprising a storage component configured to store at least one digitized verbal identifier for at least one contact of the list of contacts (see Column 5, Lines 13-19).

Katzur also discloses a voice recognition component configured to receive and digitize a verbal expression from the user (see Column 4, Lines 58-67), and to designate the contact with a digitized verbal identifier that matches the digitized verbal expression as the selected contact (see Column 5, Lines 1-6 and Lines 13-19).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the remote control, as taught by August, to include the voice recognition system, as taught by Katzur, for the purpose of allowing a vision

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impaired person to answer the telephone using voice commands (see Column 5, Lines 35-38 of Katzur).

Referring to claim 46, see the rejection of claim 9.

7. Claims 18 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. (U.S. Patent No. 5,671,267) in view of Oba et al. (U.S. Patent No. 6,832,083).

Referring to claim 18, August discloses all of the limitations in claim 16, but fails to teach that the identifiers comprise a picture of the contact.

Oba discloses that when a call has arrived and accepted, displaying an image of the person the subscriber is talking with (see Figure 26).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the remote control, as taught by August, using the image identifiers, as taught by Oba, for the purpose of preventing such an event that a user cannot fully enjoy television programs (see Column 1, Lines 37-39 of Oba).

Referring to claim 55, see the rejection of claim 18.

8. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. (U.S. Patent No. 5,671,267) in view of Fernandez et al. (U.S. Patent No. 6,339,842).

Referring to claims 36-37, August disclose all of the limitations in claim 35, as well as a set top box and initiating communication with the selected contact via a

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second interactive television (see the rejection of claims 1, 8 and 20), but fails to teach a broadband or Internet communication component.

Fernandez discloses a set-top box/DTV in Figure 3, which is used to provide conferencing between users and also uses a broadband communications component such as the Internet as a communication medium to do so (see Column 1, Line 63 through Column 2, Line 34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the telephone network, as taught by August, to utilize the Internet, as taught by Fernandez, for the purpose of emulating luxury-suite or otherwise more collaborative, intimate or personal conditions among associated audience members located at different location (see Column 5, Lines 1-6 of Fernandez).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason P Salce
Patent Examiner
Art Unit 2614

September 26, 2005

Jason Salce
9-26-05